



T-A
9/24/03
RE 14/08/03
w/Amst
B
ATTORNEY DOCKET NO. TB 104IA CA/ 1915/13971U804

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Applicants:

Grooms, James, *et al.*

U.S. Serial No.: 09/905,683

Filed: July 13, 2001

For: "CORTICAL BONE CERVICAL SMITH-
ROBINSON FUSION IMPLANT"

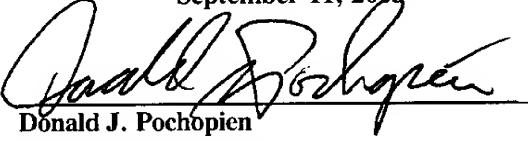
Group Art Unit: 3738

Examiner: Bruce Edward Snow

CERTIFICATE OF MAILING

I hereby certify that this paper (and all papers referred to herein) is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

September 11, 2003


Donald J. Pochopien
Registration No. 32,167
Attorney for Applicants

PRELIMINARY AMENDMENT AND
RESPONSE TO A RESTRICTION UNDER 35 U.S.C. § 121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Restriction of invention under 35 U.S.C. § 121, dated 07/06/03, for which a Response is due 09/06/03, now extended 1 month to 10/06/03, the Applicants hereby elect to prosecute the invention of Species 3 (Figure 7), with traverse. The Applicants respectfully submit that the implant of alleged Species 5 (Figure 9), is merely the implant of Species 3 (Figure 7) with a bone plug in the center hole of the implant. Thus, any claim directed to the implant of Species 3 (Figure 7) that used the word "comprising" would inherently read on the implant of Species 5 (Figure 9). For these reasons, Species 3 and Species 5 are clearly a single invention and should be combined for examination.

RECEIVED
SEP 16 2003
TC 3700 MAIL ROOM

In addition, the Applicants respectfully submit that Species 7, 9 and 11 differ from one another in size only. As a result, Species 7, 9 and 11 should be grouped together as a single species. Like the relationship between Species 5, which is merely the implant of Species 3 with a plug in the center hole, Species 8, 10 and 12, are the implants of Species 7, 9 and 11, respectively, with a plug in the center hole. Thus, any generic claim to the implant of Species 7 that did not mention size and that used the open-ended term "comprising", would read on the implants of Species 8-12 as well. For these reasons, the implants of Species 7-12 should be combined.

The Applicants respectfully submit that the broad invention made by the Applicants is the concept of making a shaped implant out of several smaller components of cortical bone, alone or in combination with cancellous bone, that are assembled to make the larger shaped implant, wherein the larger pieces are held together without glue but by a plug or one or more bone pins. With that concept in mind, the Applicants respectfully submit that Species 3, 5 and 7-12 are a part of the single inventive concept and should be considered together as a single invention.

Identification of claims associated with species:

Species 3: Claims 1-16, 38-49, 50-53.

Species 3 and 5: Claims 1-16, 17-30, 38-49, 50-53, 54-58.

Species 3, 5, 7-12: Claims 1-16, 17-30, 38-49, 50-53, 54-58.